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10/665,440	09/17/2003	David M. Skinlo	Q137-US7	7319
31815 7590 12/12/2007 MARY ELIZABETH BUSH QUALLION LLC P.O. BOX 923127 SYLMAR, CA 91392-3127			EXAMINER LEE, CYNTHIA K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/665,440
Filing Date: September 17, 2003
Appellant(s): SKINLO, DAVID M.

Travis Dodd
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/25/2007 appealing from the Office action mailed 4/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The statement of the related appeals and interferences contained in the brief is correct.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The claim rejections under 35 U.S.C. 1112, first paragraph, as based on a disclosure which is not enabling on claims 66-79.

The subject matter "electrically conductive terminal pin being electrically insulated from the case" is critical or essential to the practice of the invention, but not included in the claim, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In the instant specification, the pin needs to be insulated from the case by dielectric disks (16,18) and a glass hollow cylinder (20) to prevent short-circuiting in the battery. See page 6, lines 28-30.

(10) Response to Argument

*Applicant argues that the specification does not teach that insulation of the pin from the case is critical to the method of constructing the battery. Applicant supports this argument by stating that 1) the specification actually teaches embodiments of the battery where the pin need not be insulated from the case; 2) the specification teaches that "the battery case itself **generally** functions as the other battery terminal" at pg 3, lines 19-20 (emphasis in argument).*

To give a general background, a typical battery has two terminals, a positive and a negative terminal. The positive terminal is connected to the positive electrode and the negative terminal is connected to the negative electrode. An electrical connection between the positive terminal (or electrode) with the negative terminal (or electrode) would cause a short circuit. For example, that's the very reason for the separator (or

sep) being placed between the positive (or pos) and negative (or neg) electrode (Specification pg 9, lines22-24).

It is noted that the specification pg 6, lines 20-30 discloses that the pin needs to be insulated from the case by dielectric disks (16,18) and a glass hollow cylinder (20).

Applicant's two points are addressed below:

1) Applicant alleges that embodiments of the battery where the pin need not be insulated from the case are taught by the Specification. This assertion has no basis for the Applicant has not pointed out in the Specification any examples referred to by the Applicant.

2) Although Applicant argues that "generally" refers to conditions that are not always true, the Examiner's position is supported by the Specification pg 6, line 28 to pg 7, line 2, which states that:

The pin 12 extends through, and is hermetically sealed to a header 14. The header 14 is comprised of dielectric disks, e.g., ceramic, 16 and 18 which sandwich a glass hollow cylinder 20 therebetween. The glass hollow cylinder is hermetically sealed to the pin 12. The outer surface of the glass hollow cylinder 20 is sealed to the inner surface of an electrically conductive hollow member 22, e.g., titanium-6Al-4V. As will be seen hereinafter, the conductive hollow material 22 functions as a battery case endcap in the final product to be described hereinafter.

In other words, the pin 12 is insulated from the header 14 by dielectric disks 16 and 18 and glass 20 because the header 14 functions as a battery case endcap. Refer to fig. 2. This configuration is to isolate the pin (one terminal) from the header (another

terminal) in which "the pin extends through a battery case endcap and functions as one of the battery terminals" (specification pg 3, lines 18-19).

Furthermore, to rebut Applicant's Thought Exercise on pg 8 of the Appeal Brief, the following pointed are noted. Applicant argues that the specification does not disclose that the insulation of the pin from the case is critical to the battery construction. Applicant further argues that the battery case generally, and not always, functions as the other battery terminal (Spec. pg 3, lines 19-20). Say, for instance, that the battery case does not function as the other battery terminal. Keeping in mind that the battery necessarily requires "the other terminal", the question becomes "what part of the battery constitutes the other battery terminal?" The answer lies in the Specification pg 4, lines 16-20, "the jellyroll assembly is formed with a flexible electrically conductive tab extending from the negative electrode substrate for electrical connection to the battery case" and that "the tab is welded to a second endcap which is in turn welded to the case." In conclusion, since the pin is the "one terminal" (Spec pg 3, lines 18-19), "the other terminal" is necessarily the battery case.

To summarize, the subject matter "the electrically conductive terminal pin has to be electrically insulated from the case" is critical or essential to the practice of the invention. The pin must to be insulated from the case by dielectric disks (16,18) and a glass hollow cylinder (20) to prevent short-circuiting in the battery.

The above argument further establishes that the subject matter "the electrically conductive terminal pin has to be electrically insulated from the case" is not a preferred embodiment, but essential to the invention.

Applicant argues that the "originally filed claim 58" cannot be used to support enablement.

The Examiner agrees with the Applicant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Cynthia Lee

Conferees:

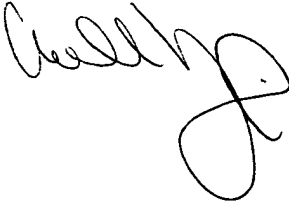


Carol Chaney

Application/Control Number:
10/665,440
Art Unit: 1795

Page 7

William Krynski

A handwritten signature in black ink, appearing to read 'William Krynski', with a large, stylized flourish at the end.